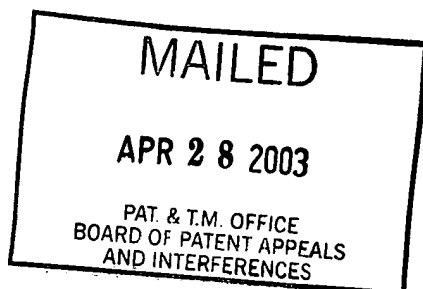




## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

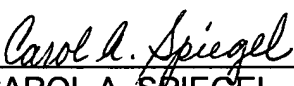
Filed by: Judge Carol A. Spiegel  
Telephone: (703) 308-9797  
Facsimile: (703) 305-0942



Applicants: MURAKAWA  
Application No.: 07/402,450  
Filed: 09/01/89  
For: METHOD FOR AMPLIFICATION AND  
DETECTION OF RNA SEQUENCES  
Accorded benefit: Application Nos.  
07/143,045, filed 01/12/88; 07/148,959, filed 01/27/88

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,055.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

  
\_\_\_\_\_  
CAROL A. SPIEGEL  
Administrative Patent Judge

The opinion in support of the decision being  
entered today is not binding precedent of the Board.

Paper 1

By: Carol A. Spiegel  
Administrative Patent Judge  
Box Interference  
Washington, DC 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Filed: April 28, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

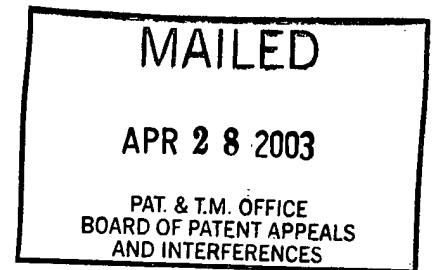
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Carol A. Spiegel)

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ALICE M. WANG, MICHAEL E. DOYLE  
and DAVID F. MARK

Junior Party,  
U.S. Patent 5,219,727  
U.S. Patent 5,476,774



v.

GEORGE J. MURAKAWA, R. BRUCE WALLACE,  
JOHN A. ZAIA and JOHN J. ROSSI

Senior Party,  
Application 07/402,450

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Patent Interference No. 105,055

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**Part A. Declaration of interference**

An interference is declared (35 U.S.C. §135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Judge designated to handle the interference**

Administrative Patent Judge Carol A. Spiegel has been designated to handle the interference. 37 CFR § 1.601(a).

**Part C. Standing order**

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

**Part D. Conference call to set dates**

A telephone call to set dates for taking action in the interference is scheduled for **2:00 p.m. on June 23, 2003** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

The parties were also invited to consider participation in a voluntary electronic filing pilot project. A sample order setting procedures for electronic transmittal of papers is attached (see <http://www.uspto.gov/web/offices/dcom/bpai/its.htm>, University of New Mexico v. Fordham University, Interference No. 104,671, Paper 21).

**Part E. The parties involved in this interference are:**

Junior party

Named inventor: ALICE M. WANG, Walnut Creek, California  
MICHAEL D. DOYLE, Oakland, California  
DAVID F. MARK, Plainsboro, New Jersey

Patent: U.S. Patent 5,219,727,  
issued June 15, 1993,  
based on U.S. application 07/413,623,  
filed September 28, 1989

Title: Quantitation of Nucleic Acids Using the Polymerase Chain  
Reaction

Assignee: HOFFMAN-LA ROCHE INC.

Accorded benefit: U.S. application 07/396,986,  
filed August 21, 1989

---

Patent: U.S. Patent 5,476,774,  
issued December 19, 1995,  
based on U.S. application 08/028,464,  
filed March 9, 1993

Title: Quantitation of Nucleic Acids Using the Polymerase Chain  
Reaction

Assignee: HOFFMANN-LA ROCHE INC.

Accorded benefit: U.S. application 07/413,623,  
filed September 28, 1989,  
now U.S. Patent 5,219,727,  
issued June 15, 1993

U.S. application 07/396,986,  
filed August 21, 1989

Attorneys: See last page

Address: See last page

Senior party

Named inventors:       GEORGE J. MURAKAWA, Cypress, California  
                              R. BRUCE WALLACE, South Pasadena, California  
                              JOHN A. ZAIA, Arcadia, California  
                              JOHN J. ROSSI, Glendora, California

Application:             U.S. application 07/402,450,  
                              filed September 1, 1989

Title:                    Method for Amplification and Detection of RNA Sequences

Assignee:               CITY OF HOPE

Accorded benefit:       U.S. application 07/143,045,  
                              filed January 12, 1988

                              U.S. application 07/148,959,  
                              filed January 27, 1988

Attorneys:              See last page

Address:                 See last page

**Part F. Counts and claims of the parties:**

Count 1

Wang (5,219,727) claim 1 or Wang (5,476,774) claims 5, 15 or 17 or Murakawa (07/402,450) claims 34, 35, 44, 46 or 47.

Count 2

Wang (5,476,774) claim 1 or Murakawa (07/402,450) claim 45.

The claims of the parties are:

Wang (5,219,727)	1-10
Wang (5,476,774)	1-18
Murakawa (07/402,450)	34-35, 38-39, 42-47

The claims of the parties which correspond to Count 1 are:

Wang (5,219,727)	1-4, 6-10
Wang (5,476,774)	5-7, 10-12, 15-18
Murakawa (07/402,450)	34-35, 38-39, 42-44, 46-47

The claims of the parties which correspond to Count 2 are:

Wang (5,219,727)	none
Wang (5,476,774)	1-3, 8-9
Murakawa (07/402,450)	45

The claims of the parties which do not correspond to either Count 1 or Count 2, and therefore are not involved in the interference, are:

Wang (5,219,727)	5
Wang (5,476,774)	4,13-14
Murakawa (07/402,450)	none

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See  
§ 18 of the STANDING ORDER.

\_\_\_\_\_ Paper \_\_\_\_<sup>1</sup>

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.  
Name of backup counsel, Esq.  
Street address  
City, State and Zip-Code  
Tel:  
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Carol A. Spiegel)

\_\_\_\_\_  
ALICE M. WANG, MICHAEL E. DOYLE  
and DAVID F. MARK

Junior Party,  
U.S. Patent 5,219,727  
U.S. Patent 5,476,774

v.

GEORGE J. MURAKAWA, R. BRUCE WALLACE,  
JOHN A. ZAIA and JOHN J. ROSSI

Senior Party,  
Application 07/402,450

\_\_\_\_\_  
Patent Interference No. 105,055

\_\_\_\_\_  
TITLE OF PAPER

\_\_\_\_\_  
<sup>1</sup> Leave a blank line because the Board assigns the paper number.

**Part H. Summary of dates for taking action**

Times for taking action are set out in the following sections of the **STANDING ORDER**:

1.    **§ 7:**   date for identifying lead and backup counsel.
2.    **§ 8:**   date for identifying any real party in interest.
3.    **§ 9:**   date for requesting copies of involved and benefit applications and patents.
4.    **§ 17:**  date for filing list of proposed preliminary motions.
5.    **§ 19:**  date for accomplishing certain discovery.
6.    **§ 20:**  date for filing clean copy of claims.
7.    **§ 21:**  date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8.    **§ 23:**  dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9.    **§ 33:**  date for objecting to admissibility of evidence.
10.   **§ 34:**  date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11.   **§ 35:**  dates when cross-examination can take place.
12.   **§ 45:**  dates for taking action with respect to settlement discussions.



**Part I. Order form for requesting file copies**

**FILE COPY REQUEST**

Interference 105,055 (CAS)

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

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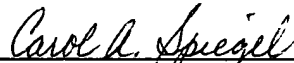
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Telephone, including area code: \_\_\_\_\_

**Part J. Signature of administrative patent judge**

  
\_\_\_\_\_  
CAROL A. SPIEGEL  
Administrative Patent Judge

Date: April 28, 2003  
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference (ORDERTE6)

Copy of U.S. Patent 5,219,727

Copy of U.S. Patent 5,476,774

Copy of claims of application 007/402,450

Copy of sample order setting procedures for electronic transmittal of papers

Interference No. 105,055  
Wang v. Murakawa  
cc (via overnight mail):

Paper 1  
Page 10

Attorney for Wang  
(real party in interest  
HOFFMANN-LA ROCHE INC.):

Stacy R. Sias  
ROCHE MOLECULAR SYSTEMS INC.  
Patent Law Department  
1145 Atlantic Avenue  
Alameda, CA 94501  
Tel: 510-814-2972  
Fax: 510-814-2973

Attorney for Murakawa  
(real party in interest  
CITY OF HOPE):

E. Anthony Figg, Esq.  
ROTHWELL, FIGG, ERNST & MANBECK  
1425 K Street, N.W.  
Suite 800  
Washington, D.C. 20005  
Tel: 202-783-6040  
Fax: 202-783-6031

**INTERFERENCE DIGEST**

Interference No. 105,055

Paper No. 48

Name: George J. Murakawa et al.

Serial No.: 07/402,450

Patent No.

Title: METHOD FOR AMPLIFICATION AND DETECTION OF RNA SEQUENCES

Filed: 09/01/89

Interference with Wang et al.

**DECISION ON MOTIONS**

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

**FINAL DECISION**

Board of Patent Appeals and Interferences, Adverse Dated, 4/5/04

\_\_\_\_\_

Court, \_\_\_\_\_ Dated, \_\_\_\_\_

**REMARKS**

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

This should be placed in each application or patent involved in interference in addition to the interference letters.